

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:) Art Unit: 1639
)
CHRISTENSEN, et al.) Examiner: STEELE, A.
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Serial No.: 10/529,397) Washington, D.C.
)
Filed: March 28, 2005) April 14, 2009
)
For: SPATIALLY ENCODED) Docket No.: CHRISTENSEN=12
 POLYMER MATRIX)
) Confirmation No.: 6716

SUPPLEMENTAL ELECTION AND
PETITION TO VACATE HOLDING OF INCOMPLETENESS

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S i r :

In response to the PTO Communication dated March 31, 2009,
Applicant responds as follows:

1. Supplemental Election

1.1. Applicants further elect, in response to species restriction (c) for group I, that there are four (4) particles/bead. All group I claims read on the elected species.

1.2. Applicants repeat the elections previously made for species restrictions (e), (f) and (g), and explain below (section 2.2) why those elections are consistent ("correlated").

2. Petition to Vacate

Applicants petition the Commissioner to exercise supervisory authority under 37 CFR 1.181 and vacate the holding of non-responsiveness made on March 31, 2009.

In the November 20, 2007 restriction, the examiner made separate species restrictions for groups I, II, III, IV, V, VI and IX. Since we elected group II with traverse (January 17, 2008), we were under no obligation to make species elections for other groups. Nonetheless, we made prospective elections for

group I, see §5 of the election.

The Examiner has apparently decided that the amendments and/or arguments presented in our September 10, 2008 amendment rendered our main claim (32) allowable, warranting rejoinder under MPEP 821.04 of all withdrawn method claims which are directly or indirectly dependent on that claim. For example, group I claims 2-9 are directly dependent, and group I claims 10-31 are indirectly dependent, on claim 32.

The Examiner says that the amendment to claims 2-31 which made them dependent on 32 was filed January 8, 2009, but that amendment merely cancelled claims 104-5. The dependencies of claims 2-31 were revised by the September 10, 2008 amendment.

The Examiner belatedly holds (1) our original "prospective" species election in response to group II species restriction (c) was insufficiently specific and hence incomplete, and (2) our original species elections in response to group II species restrictions (e)-(g) did "not correlate" with each other, i.e., were inconsistent.

We traverse the holding of non-responsiveness on two grounds.

2.1. First, since the Examiner made the species restrictions in question conditional on election of group I, and we elected group II, our response to the November 20, 2007 restriction requirement was complete and would have been complete even if we had made no attempt whatsoever to respond the group I species restrictions.

Had we been silent on that subject, the Examiner would have mailed a new restriction requirement advising us that group I was rejoined and requiring us to respond to the species restrictions (a)-(g) associated with that group.

Thus, we are being penalized for attempting to expedite prosecution by making a prospective Group I species election back in 2008. We do not believe that the penalty for any failure to make a complete prospective response to an untriggered conditional species election could be more than having the

issuance of our patent delayed by having to respond to a new restriction requirement.

It also seems to us that having done the PTO the courtesy of making prospective species elections for group I, if there were problems with those elections, they should have been mentioned in the first action on the merits (April 10, 2008).

2.2. Secondly, we believe that our responses to the species restrictions were in fact complete for the reasons explained below.

2.2.1. The precise wording of restriction (c) was "a species of particle number (claims 7-9)". We elected the range, 4 to 10 particles, set forth in claim 7. The Examiner now takes the position that this was non-responsive; that we should have elected a single number, not a range. In view of the examiner's reference to claims 7-9 in defining the restriction, we believe we reasonably interpreted the restriction as requiring the election of the subject matter of one of claims 7-9, i.e., the range of claim 7 (4-10), of claim 8 (4-8) or of claim 9 (less than 5).

The Examiner is of course at liberty to subsequently impose a more stringent species restriction, requiring election of a single number. But such should not be done in the guise of a complaint that the original species election was defective.

2.2.2. The species restrictions (e)-(g) were as follows:

- e. a species of marker (claims 17-20 and 27)
- f. a species of detection (claims 21-23 and 27-31)
- g. a species of polymer (claims 24-26).

In response, we elected

- e. spectroscopically detectable marker (claim 17),
- f. marker detected by probing with one or more predetermined frequencies (claim 31) and
- g. optically transparent polymer (claim 24).

The Examiner states that election (e) "does not correlate"

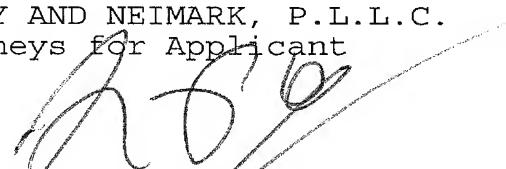
with election (f) or (g). We disagree.

Election (f)'s "probing" clearly contemplates irradiation of the beads with exciting radiation of "one or more predetermined frequencies", causing the marker to fluoresce. Fluorescence is "spectroscopically detectable", consistent with election (e). The polymer of claim 24 is the matrix of the bead. It being "optically transparent" facilitates excitation of the marker and observation of the fluorescence. Indeed, claim 24 recites "optically transparent in the optical excitation of said fluorescent marker and/or the emission wavelengths of said fluorescent marker".

Hence, these elections are in fact "correlated".

Respectfully submitted,

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